

## REMARKS

In the Office Action mailed October 4, 2006, the following issues were raised:

1. Claims 7 & 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,732,237 to Jacobs et al.; and
2. Claims 1-6, 8, and 11-16 were rejected under 35 U.S.C. § 103(a) as being obvious over the Jacobs et al. reference in view of the Official Notice taken by the Examiner.

Applicant has amended paragraphs 25 and 28 of the specification to indicate that the computer interface 203 enables the CBD 202 to be used as a direct attached storage peripheral. Such use of the CBD is inherent from the original specification, which includes a list of protocol formats (IDE, ATA, SCSI, and IEEE 1394), all of which were designed for, as of the time of filing the present application, connecting a computer to a direct attached storage peripheral. For the foregoing reasons, no new matter has been added.

Moreover, a direct attached storage peripheral is distinguishable from a network attached storage peripheral in the sense that the former is accessible only by or through the computer to which it is directly attached, and the latter is accessible to any authorized computer residing within the same network. While each type of storage peripheral has its advantages and disadvantages, which are appreciated by those skilled in the art, those skilled in the art will recognize that they are not interchangeable without wholesale replacement of the interface hardware.

### Anticipation Rejections

Claim 7 was rejected as anticipated by the Jacobs et al. reference. A finding of anticipation requires that each and every element of the claimed invention be described,

either expressly or inherently, in a single prior art reference. As amended, claim 7 includes the limitation of "wherein the storage device is in communication with the computer as a direct attached storage peripheral". The Jacobs et al. reference does not disclose this limitation.

The Jacobs et al. reference discloses a cache server 102 which is connected to and accessible by a plurality of user workstations 108a, 108b, 108c via a network 104, such as the Internet. That the cache server 102 is accessed over a network by workstations 108a, 108b, 108c is clearly illustrated in Fig. 1. Thus, the cache server 102 is essentially a network attached storage peripheral, and the Jacobs et al. reference does not teach the limitation of a direct attached storage peripheral. For this reason, the Jacobs et al. reference does not anticipate amended claim 7.

Claim 9 depends from claim 7 and was also rejected as anticipated by the Jacobs et al. reference. Where the Jacobs et al. reference does not anticipate claim 7, it also does not anticipate claim 9.

### Obviousness Rejections

The remaining rejections in the Office Action are based upon obviousness. The MPEP has set the following standard for establishing a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 2142. For the reasons discussed below, the combination of the Jacobs et al. reference and the matter of Official Notice fails to teach or suggest all of the limitations

in the rejected claims. The cited combination is therefore insufficient to establish a *prima facie* case of obviousness over the rejected claims.

Claim 1 was rejected as obvious over the Jacobs et al. reference in view of the Official Notice taken by the Examiner. This Official Notice relates the storage device returning a "file unavailable notice" to the computer when a requested file is not cached and is not available from the file server. As amended, claim 1 includes the limitation of "wherein the processor appears to the computer as a direct attached storage peripheral". This limitation is not taught or suggested by the Jacobs et al. reference and is not the subject of the Official Notice.

As discussed above in relation to the anticipation rejection of claim 7, the Jacobs et al. reference does not include any teachings or suggestions relating to direct attached storage peripherals. Rather, the entirety of the Jacobs et al. reference focuses on the cache server 102 as being essentially a network attached storage peripheral. Therefore, the Jacobs et al. reference does not teach or disclose all the limitations of amended claim 1. Further, the matter of Official Notice also fails to teach these limitations. For this reason, the cited combination does not establish a *prima facie* case of obviousness over amended claim 1.

Claims 2 & 3 each ultimately depend from amended claim 1. Where the Jacobs et al. reference and the matter of Official Notice do not establish a *prima facie* case of obviousness over amended claim 1, the cited combination also does not establish a *prima facie* case of obviousness over claims 2 & 3.

Claim 4 was also rejected as obvious over the combination of the Jacobs et al. reference in view of the matter of Official Notice. Amended claim 4 includes the limitation of "the storage device being in communication with the computer as a direct attached storage peripheral". For the same reason discussed above with reference to amended claim 1, the cited combination does not establish a *prima facie* case of obviousness over amended claim 4.

Claims 5 & 6 each ultimately depend from claim 4. Where the Jacobs et al. reference and the matter of Official Notice do not establish a *prima facie* case of obviousness over claim amended 4, the cited combination also does not establish a *prima facie* case of obviousness over claims 5 & 6.

Claims 8 & 16 were also rejected as obvious over the combination of the Jacobs et al. reference in view of the matter of Official Notice. Claims 8 & 16 depend from claim 7, and as discussed above, the Jacobs et al. reference does not disclose all of the limitations of amended claim 7. Moreover, the matter of Official Notice fails to fill in the gaps in the teachings of the Jacobs et al. reference. Therefore, the cited combination does not establish a *prima facie* case of obviousness over claims 8 & 16.

Claim 11 was also rejected as obvious over the combination of the Jacobs et al. reference in view of the matter of Official Notice. As amended, claim 11 includes the limitation of "wherein the processor appears to the computer as a direct attached storage peripheral". As discussed above with reference to amended claim 1, neither the Jacobs et al. reference nor the matter of Official Notice teach or suggest this limitation. Therefore, the cited combination does not establish a *prima facie* case of obviousness over amended claim 11.

Claims 12 & 13 each ultimately depend from claim 11. Where the Jacobs et al. reference and the matter of Official Notice do not establish a *prima facie* case of obviousness over amended claim 11, the cited combination also does not establish a *prima facie* case of obviousness over claims 12 & 13.

Claim 14 was also rejected as obvious over the combination of the Jacobs et al. reference in view of the matter of Official Notice. Claim 14 includes the limitation of "the storage device being in communication with the computer as a direct attached storage peripheral". As discussed above with reference to amended claim 11, neither the Jacobs et al. reference nor the matter of Official Notice teach this limitation. Therefore,

the cited combination does not establish a *prima facie* case of obviousness over amended claim 14.

Claim 15 depends from claim 14. Where the Jacobs et al. reference and the matter of Official Notice do not establish a *prima facie* case of obviousness over amended claim 14, the cited combination also does not establish a *prima facie* case of obviousness over claim 15.

For each of the above reasons, reconsideration of the rejections is requested.

Respectfully submitted,

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